



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,899	11/19/2001	Hendricus Renerus Jacobus Mattheus Hoogenboom	DX/003 CON	9170
1473	7590	12/09/2003	EXAMINER	
FISH & NEAVE 1251 AVENUE OF THE AMERICAS 50TH FLOOR NEW YORK, NY 10020-1105			PONNALURI, PADMASHRI	
			ART UNIT	PAPER NUMBER
			1639	

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/988,899

Applicant(s)

HOOGENBOOM, HENDRICUS
RENERUS JACOBUS M

Examiner

Padmashri Ponnaluri

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3, 10, drawn to a plurality of polynucleotides encoding a Fab library, comprising a plurality of vectors, a polynucleotide encoding an anchor region, a first and second plurality of variable polynucleotides, and a vector, classified in class 435, subclass 6.
 - II. Claim 4, drawn to a Fab library comprising a plurality of vectors, a polynucleotide encoding an anchor region, a first and second plurality of variable polynucleotides, a plurality of capsid particles, classified in class 530, subclass 387.1.
 - III. Claims 5-6, drawn to a method of making a plurality of polynucleotides encoding a Fab library, classified in class 435, subclass 69.1.
 - IV. Claim 7, drawn to a method of making a Fab library wherein the plurality of vectors are packaged into a plurality of capsid particles, classified in class 435, subclass 69.1.
 - V. Claim 8, drawn to a method for obtaining a Fab clone with specificity a target, classified in class 435, subclass 5.
 - VI. Claim 9, drawn to monoclonal Fab or polyclonal collection of Fab, classified in class 530, subclass 387.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of group I, II, IV, and VI are all drawn to patentably distinct products. The different products of groups I, II, IV and VI are not disclosed as capable of use together and they

Art Unit: 1639

have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Thus, the restriction between the groups is proper.

3. Inventions of groups III, and V are drawn to distinct methods, which methods are not capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Thus restriction between the groups is proper.

4. Inventions of groups I, II, IV and VI are drawn to different products and groups III, V are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the different products of groups I, II, IV and VI can be prepared by various other well known techniques in the art, and the methods of making of groups III, V can be used to obtain products other than the product inventions of this application. Thus restriction between the groups is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1639

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padmashri Ponnaluri whose telephone number is 703-305-3884. The examiner is on Flex Schedule and can normally be reached on Monday through Friday from 7 AM and 3.30 PM.

NOTE that the examiner's telephone number will be changed to (571)-272-0809 after 02/02/2004.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 703-306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0916.

Padmashri Ponnaluri
Primary Examiner
Art Unit 1639

Pp
05 December 2003


PADMASHRI PONNALURI
PRIMARY EXAMINER